

### REMARKS

Claims 8-16 and 18-23 are pending. No claims are added, amended, or canceled.

Claims 7-16 and 18 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over WO 99/54524 ("the Newman application") in view of U.S. Patent No. 5,592,686 ("the Third patent"). Applicant respectfully traverses the obviousness rejection because a proper *prima facie* obviousness rejection under 35 U.S.C. § 103(a) has not been established.

To establish a *prima facie* case of obviousness, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Moreover, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The reason to make the claimed combination, and a reasonable expectation of success, must be found elsewhere than in Applicants disclosure, such as in the prior art, the nature of the problem to be solved, or in the knowledge/understanding of the person of ordinary skill in the art. MPEP § 2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As admitted by the Office, the Newman application does not teach the use of a pore former material. Office Action at page 2. In an attempt to cure this defect, the Office recites the teaching of the Third patent. The use of a pore forming material in the Third patent, however, is an optional component. *See*, for example, the Abstract. Applicants submit that there is no reason to import an optional component of the Third patent into the teachings of the Newman application; there is no suggestion of any benefit to doing so. In responding to these arguments in our previous response, the Office stated that "[t]he standard that it must be obvious to try is not found in the MPEP." Office Action at page 6. Applicants agree and do not allege that this is the standard. Rather, Applicants reiterate that no cogent reason exists to make the combination of the elements.

Furthermore, even when the optional pore former is utilized in the Third patent, there is no teaching directing one skilled in the art to derive the limitations of the instant claims regarding a defined pore diameter between about 0.01  $\mu\text{m}$  and about 50  $\mu\text{m}$  and a tensile strength between about 5 and about 500 N/mm<sup>2</sup>. The Office argues that the Newman application teaches "practically every requirement in regards to mechanical, thermal and/or

chemical resistance can be met” then argues motivation to add an optional agent from the Third patent to meet these requirements (Office Action at pages 2-3). The argument that the Newman application teaches that desired properties could be obtained within the Newman application’s teachings would seem to negate the motivation to combine the art. As noted in the Final Rejection (page 2), Neumann teaches that “a membrane of this type can be manufactured with a porosity defined with narrow tolerances and small flow resistance, such that the porosity is determined essentially through the specification of the particle size and the flow resistance is determined through the thickness and the particle size of the sintered metal film. By the selection of the metal to be applied, metal alloys and/or the metal powder mixtures for the metal powder, practically every requirement in regard to mechanical, thermal and/or chemical resistance can be met.” Column 4, lines 20-29. This passage argues against a motivation to combine the art as Neumann already teaches how to control pore size by alternate methods.

In addition, it appears that the combination of the Newman application with the Third patent in the final rejection is based on the assumption that the Newmann application discloses that "based on the selection of metal to be applied, practically every requirement regards mechanical, thermal and/or chemical resistance can be met". Column 4, lines 20-29. According to the clear wording of said disclosure of the Newmann application, however, the same is restricted to the selection of metals (*see*, for example, column 4, lines 20-29), whereas according to the wording of independent claim 18 on file not only the metal, but also a pore forming material is used in order to influence the mechanical properties, especially the tensile strength.

For any of the reasons cited above, the rejection should be withdrawn.

Claims 19-23 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over the Newman application in view of the Third patent and further in view of paragraph 3 of Applicant’s disclosure. This rejection relies upon the combination of the Newman application and the Third patent as discussed in the previous paragraphs. For reasons detailed above, the combination is improper. For at least this reason, the rejection should be withdrawn.

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**PATENT  
REPLY FILED UNDER EXPEDITED  
PROCEDURE PURSUANT TO  
37 CFR § 1.116**

Applicants believe the foregoing constitutes a complete response to the Office Action and submit that all pending claims are in condition for ready allowance. An early Office Action to that effect is, therefore, earnestly solicited.

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Respectfully submitted,

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